

REMARKS

Response to Advisory Action

This Amendment is submitted in response to the final Office Action mailed December 3, 2003, and to an Advisory Action mailed on May 18, 2004. In the Advisory Action, the Examiner refused to enter the Amendment After Final on the grounds it necessitated a new search; however, in statements accompanying the Advisory Action, the Examiner remarked that applicant's arguments "are similar to the arguments presented in the last Office Action and the Examiner had [sic] already addressed these issues."

Applicant respectfully disagrees with the inconsistent position taken by the Examiner. Applicant's arguments in the Amendment After Final were directed in part to the "newly-added limitations" that the Examiner believes requires further consideration and/or a further search. So, either applicant's arguments were new, and thus the supposed new claim limitations required further examination; or the arguments were similar and thus the associated claim limitations did not require further search and consideration, and the Amendment After Final should have been entered to put the case in a better form for appeal. Since the Examiner chose the point of view that the claim limitations were new by not entering these amendments, the Examiner therefore not only needs to address these limitations, but also needs to address applicant's arguments regarding these limitations. These arguments have not yet been addressed by the Examiner.

Applicant respectfully requests that the Examiner fully and completely address applicant's arguments submitted herewith.

Response to Final Office Action

Claims 1-52, 57-68, and 73-82 are presented for further examination. Claims 1-8, 10, 12, 17, 19, 22-24, 27, 30, 32, 34, 37, 39, 41, 44-46, 51-52, 58, 60-62, 67-68, 74, 76, 79, and 82 have been amended.

In the final Office Action mailed December 3, 2003, the Examiner requested a descriptive, brief, and technically accurate title. Applicant has amended the title to conform to 37 C.F.R. § 1.72.

The Examiner rejected claims 1-22, 78-79, and 45-60 under 35 U.S.C. § 101 because the claimed invention was directed to non-statutory subject matter inasmuch as the body of the claims did not refer to any device or hardware or the computer system used in the preamble.

Applicant has amended the independent claims encompassed by the rejection to include the requested explicit recitation of structure. Accordingly, applicant requests that this rejection be withdrawn.

Dependent claims 12, 19, 22, 27, 32, 34, 39, 41, 44, 46, 51-52, 58, 60, 62, 67-68, 74, 76, 79 and 82 have been amended to clearly recite the respective list of elements in the disjunctive. Thus applicant has deleted "at least one of" in each instance and substituted the disjunctive "or" for "and" before the last element in the list so that the claim covers any one or more of the listed elements in the alternate. These amendments conform the claims with current case law on this subject.

Claims 1-52, 57-68, and 73-82 were rejected under 35 U.S.C. § 102(e) as anticipated by Barnett et al., U.S. Patent No. 6,321,208 (of record). The Examiner's remarks accompanying this rejection substantially mirror the remarks of the previous Office Action with the exception of the Examiner's comments regarding applicant's arguments. These comments state that "a great deal of the argued limitations is not present in the current claimed invention," and that the Examiner is relying on inherency from the teachings of Barnett et al. to reject the claims.

Applicant respectfully disagrees and requests reconsideration and further examination of the claims.

Applicant adopts and reasserts herein his arguments set forth in the Amendment filed August 27, 2003. In addition, and in response to the Examiner's assertion that Barnett et al. inherently teaches the claimed invention, applicant respectfully submits that the Examiner's inherency argument is based on an unfounded assumption that Barnett et al. teaches providing access to vendors and manufacturers for obtaining rebate information in electronic form. Barnett et al. specifically teaches that the online service provider 2 performs all of the functions, whether on a dedicated server used by the provider or at a site on the Internet (*see* Barnett et al., 13:50-53; and 13:64-14:6). In addition, Barnett et al. is not directed in any way to the coupon redemption process by a vendor and only mentions a traditional, manual redemption process, which uses well-known coupon clearing houses to process the coupons of each manufacturer in order to reimburse/pay the retailer where the coupon was redeemed by a customer (*see* Barnett et al. Figure 1 and 7:41-45).

In contrast, the disclosed and claimed embodiments of the invention are directed to a system that "relieves the owner/operator of the web server software 202 of much labor and constitutes one of the benefits of various embodiments of the present invention described herein, in

that it essentially relieves the web server owner/operator of any concerns related to the internal inventories of various manufacturers.” (See specification page 16, line 32-page 17, line 5.) In addition, the various embodiments “allow near real-time control and updating of rebate information . . . [and thus] accurate accounting with respect to amounts owed arising from various rebate transactions.” (See specification page 27, lines 14-23.)

Nothing in Barnett is addressed to solving the problems surrounding an accurate accounting of rebate transactions for vendors. It is clear from the teachings of Barnett et al. that the service provider, not the vendors or manufacturers, maintains strict control over access to the coupon redemption data. Nowhere does Barnett et al. teach, motivate, or suggest that a vendor or manufacturer have any electronic access to the coupon data management routines or the underlying data in electronic form in order to retrieve *in near real-time* data regarding the redemption of rebates.

It is clear from the architecture of the present invention that the computer system or server that distributes coupon data is the same that maintains redemption information and responds to inquiries regarding coupon redemption and vendor-related redemption information. This architecture is what supports the claimed ability to “dispens[e] to the vendor, in near real-time, rebate redemption information related to a portion of the multi-vendor rebate list,” as recited, for example, in amended claim 1, and similarly in the other independent claims 23, 45, and 61. Nowhere do Barnett et al. teach or suggest such an architecture or any structural relationship between where the coupon data is stored (in a coupon packages file 30 of the online service provider 2) and the components of the coupon redemption centers 13. Rather, Figure 1 of Barnett et al. illustrate and describe an online service provider 2 for receiving “coupon download packages,” which is completely separate from a “coupon redemption database” 12 associated with a retailer/product checkout 10 and a coupon distributor database 11 for receiving “user redemption info” from the coupon redemption database 12.

Moreover, Barnett et al. fail to teach or even address retailer coupon redemption and the use of a computer system or other electronic means to facilitate quicker payment to a store and to facilitate retrieval of current information regarding the state of a coupon redemption. This problem is simply not addressed by Barnett.

Independent claims 1, 23, 45, and 61 all clearly recite the computer system dispensing *in near real-time* rebate redemption information *related to a vendor related portion of a*

rebate list in response to receiving an electronic message from the vendor. (Various forms of this language are recited in the independent claims as discussed below.) As previously argued by the applicant in the Amendment filed August 27, 2003, nowhere does Barnett et al. teach or suggest any mechanism for a vendor to electronically obtain information (*see* Amendment, page 23, filed August 27, 2003). These limitations are supported in the specification, page 26, lines 3-13 and Figures 6-8, wherein a redeemed rebate is scanned in at a retailer's facility and then tracked *in near-immediate time* by a retailer's computer system communicating with a computer system that maintains a multi-vendor rebate list 204 (in one embodiment a central computer system 150) to update the rebate list 204 to indicate that a coupon was redeemed and to record a corresponding rebate redemption transaction (*see also* specification, page 26, lines 20-32). A response message is also sent to indicate that a corresponding volume-of-usage counter has been incremented, as recited in claim 9.

In contrast to the present invention, there is nothing inherent in Barnett et al. about providing near real-time rebate redemption information. Rather, Barnett alludes to manual redemption processing (traditional redemption processing), which is anything but near real-time dispensing of information pertaining to rebate redemption.

This real-time access to information is specifically highlighted in the claims. For example, as amended claim 1 recites:

A computer-implemented method for tracking and processing redemption of rebates from a plurality of vendors, comprising:

maintaining in the computer system *in electronic form* a multi-vendor rebate list with data regarding redeemed rebates associated with each of the vendors;
receiving from a vendor, *in electronic form*, a message regarding the multi-vendor rebate related list; and

in response to the received message, dispensing to the vendor, *in near real-time, rebate redemption information* related to a portion of the multi-vendor rebate list associated with the vendor.

The remaining independent claims recite similar language to the portions emphasized above. Nowhere does Barnett et al. teach, disclose, or suggest maintaining in electronic form *in near real-time* a multi-vendor rebate list with rebate data, receiving *in electronic form* a multi-vendor rebate list related message from a vendor, and dispensing *in near real-time* rebate redemption information in response to the message. In view of the foregoing, applicant submits that claim 1 and all claims depending therefrom are clearly allowable over Barnett et al.

Independent claims 23, 45, and 61 are similarly directed to a computer system, a method in a computer system, and a computer-implemented system for tracking and redemption of rebates from a plurality of vendors, respectively that maintains a list and responds to vendor messages *in near real-time* to dispense information related to rebate data maintained on the rebate list. Applicant respectfully submits that these independent claims and all claims depending therefrom are also allowable for the reasons discussed above with respect to claim 1.

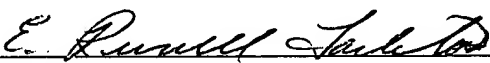
In the event the Examiner disagrees, applicant respectfully requests entry of the foregoing amendments in order to place the claims in a better form for appeal.

In the event the Examiner finds minor informalities that can be resolved by telephone conference, the Examiner is urged to contact applicant's undersigned representative by telephone at (206) 622-4900 in order to expeditiously resolve prosecution of this application. Consequently, early and favorable action allowing these claims and passing this case to issuance is respectfully solicited.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

SEED Intellectual Property Law Group PLLC


E. Russell Tarleton

Registration No. 31,800

ERT:lrj

Enclosure:

Postcard

701 Fifth Avenue, Suite 6300
Seattle, Washington 98104-7092
Phone: (206) 622-4900
Fax: (206) 682-6031

680047.404 / 484870_3